

3628
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Davis et al.

Attorney Docket No.: VISAP016

Application No.: 09/359,083

Examiner: BELL, Paul A.

Filed: July 22, 1999

Group: 3628

Title: INTERNET PAYMENT,
AUTHENTICATION AND LOADING SYSTEM
USING VIRTUAL SMART CARD

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first-class mail on February 7, 2005 in an envelope addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

Signed: _____

Ann Lowe
Ann Lowe

**REQUEST FOR REINSTATEMENT
OF PATENT APPLICATION
(37 CFR §1.8(b))**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Abandonment for the above-identified application has been received. Applicant respectfully submits that the enclosed Response was timely filed in the U.S. PTO by having been filed in accordance with 37 CFR §1.8(a) as evidenced by the documents indicated below as being submitted. Applicant requests that the Response be considered timely filed and that the abandonment of the above-identified application be withdrawn under 37 CFR §1.8(b) or other applicable rule.

Submitted herewith is:

- ☒ A copy of the Notice of Abandonment.
- ☒ A copy of the facsimile machine's transmission report.
- ☒ A copy of the complete Response previously filed.
- ☒ A statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely filing (see below).
- ☒ Statement of Jeanne Lupton (attached).

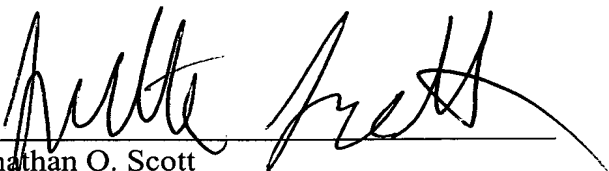
Attached is a copy of the original response filed on August 5, 2004 that includes a Request for Continued Examination, an Amendment Transmittal and Amendment D. Each of these three documents includes a certificate of transmission filed by our former patent secretary Jeanne Lupton indicating that each document was sent by facsimile to the Examiner on August 5, 2004. Also attached is a copy of our facsimile machine's transmission report indicating that the above documents were transmitted on August 5, 2004. It appears that for some reason this response was not received in the Patent Office. Jeanne Lupton was a temporary secretary at our firm during that time.

Please proceed with further examination of this application on the basis of: the original Response filed which may have now reached the appropriate area of the U.S. PTO, or the attached copy of the Response originally filed.

Acknowledgement of the withdrawal of the abandonment of the above-identified application and its resulting active status is respectfully requested.

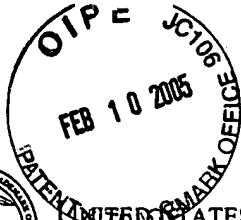
It is believed that no fees are due in connection with the filing of this request. However, if it is determined that any fees are due, the Commissioner is hereby authorized to charge such fees to Deposit Account 500388 (Order No. VISAP016).

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP


Jonathan O. Scott
Registration No. 39,364

February 7, 2005
Date

Beyer Weaver & Thomas, LLP
P.O. Box 70250
Oakland, CA 94612-0250
Telephone: (612) 252-3330
Facsimile: (612) 825-6304



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/359,083	07/22/1999	VIRGIL M. DAVIS	VISAP016	2317

22434 7590 02/01/2005

BEYER WEAVER & THOMAS LLP
P.O. BOX 70250
OAKLAND, CA 94612-0250

EXAMINER

BELL, PAUL A

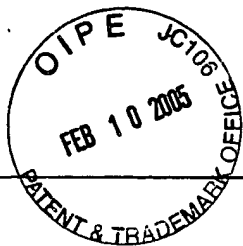
ART UNIT PAPER NUMBER

3628

DATE MAILED: 02/01/2005

 **COPY**

Please find below and/or attached an Office communication concerning this application or proceeding.



v

Notice of Abandonment

Application No.

09/359,083

Examiner

PAUL A BELL

Applicant(s)

DAVIS ET AL.

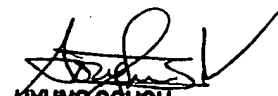
Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 06 May 2004.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:


HYUNG SOUH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

* * * COMMUNICATION RESULT REPORT (AUG. 5. 2004 5:26PM) * * *

TTI BWT LLP (BERKELEY)

TRANSMITTED/STORED: AUG. 5. 2004 5:17PM

FILE MODE	OPTION	ADDRESS (GROUP)	RESULT	PAGE
283	MEMORY TX	#	E-3) 3)	0/11

REASON FOR ERROR
E-1) HANG UP OR LINE FAIL
E-3) NO ANSWER

E-2) BUSY
E-4) NO FACSIMILE CONNECTION

FACSIMILE COVER SHEET

August 5, 2004

Receiver: Examiner Jeffrey Pwu**TEL #:** 703-308-7835**FAX #:** 703-872-9306**Sender:** Jeanne Lupton, Patent Secretary to Phillip P. Lee, Esq.**Re:** US Pat. Appln. S.N. 09/359,083

FACSIMILE COVER SHEET

August 5, 2004

Receiver: Examiner Jeffrey Pwu

TEL #: 703-308-7835

FAX #: 703-872-9306

Sender: Jeanne Lupton, Patent Secretary to Phillip P. Lee, Esq.

Re: US Pat. Appln. S.N. 09/359,083

Pages Including Cover Sheets: 11

MESSAGE:

Please see attached.

Request for Continued Examination
Amendment Transmittal
Amendment D

CONFIDENTIALITY NOTE

The information contained in this facsimile (FAX) message is legally privileged and confidential information intended only for the use of the receiver or firm named above. If the reader of this message is not the intended receiver, you are hereby notified that any dissemination, distribution or copy of this FAX is strictly prohibited. If you have received this FAX in error, please immediately notify the sender at the telephone number provided above and return the original message to the sender at the address above via the United States Postal Service. Thank you.

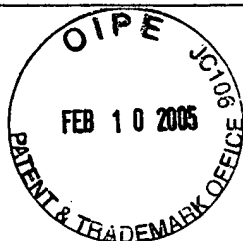
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Davis et al.

Application No.: 09/359,083

Filed: July 22, 1999

Title: INTERNET PAYMENT,
AUTHENTICATION AND LOADING SYSTEM
USING VIRTUAL SMART CARD



Attorney Docket No.:
VISAP016/P10500

Examiner: Pwu, Jeffrey C.

Group: 3628

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to the U.S. Patent and Trademark Office, Attention, Examiner Jeffrey Pwu at facsimile telephone number (703) 872-9306 on August 5, 2004.

Printed Name: Jeanne Lupton

Signed: 

**REQUEST FOR CONTINUED EXAMINATION (RCE)
(37 CFR §1.114)**

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This is a Request for Continued Examination (RCE) of the above-identified application.

1. Submission required under 37 C.F.R. §1.114:

- a. ☐ Previously submitted
 - i. ☐ Consider the amendment/reply under 37 C.F.R. §1.116 previously filed on _____.
 - ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____.
 - iii. ☐ Other _____.
- b. ☒ Enclosed
 - i. ☒ Amendment/Reply
 - ii. ☐ Affidavit/Declaration
 - iii. ☐ Information Disclosure Statement with Form PTO-1449
 - ☐ Copies of IDS Citations
 - iv. ☐ Other _____.

2. **Fees:**

Fee Calculation (37 CFR §1.16)

Fee for Request for Continued Examination Under 37 C.F.R. §1.17(e)	\$770 =	770.00
TOTAL		770.00
SMALL ENTITY 50% FILING FEE REDUCTION (if applicable)		

- ☐ a. Applicant hereby petitions for a month extension of time.
- ☒ b. Applicant believes that no (additional) extension of time is required; however, if it is determined that such an extension is required, Applicant hereby petitions that such an extension be granted and authorizes the Director to charge the required fees for an extension of time under 37 CFR §1.136 to Deposit Account No. 500388.
- ☐ c. Enclosed is our Check No. in the amount of \$ to cover the RCE fee, extension of time and additional fees.
- ☒ d. The Director is authorized to charge the RCE fee of \$770.00 and any fees beyond this amount which may be required, or to credit any overpayment, to Deposit Account No. 500388 (Order No. VISAP016).
3. ☒ Please continue to send correspondence to the following address:

Customer Number 022434

022434

Date: August 5, 2004



Phillip P. Lee
Registration No. 46,866

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Davis, et al.

Application No.: 09/359,083

Filed: July 22, 1999

Title: INTERNET PAYMENT,
AUTHENTICATION AND LOADING SYSTEM
USING VIRTUAL SMART CARD



Attorney Docket No.: VISAP016/P10500

Examiner: Pwu, Jeffrey C.

Group: 3628

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to the U.S. Patent and Trademark Office, Attention: Examiner Jeffrey Pwu at facsimile telephone number (703) 872-9306 on August 5, 2004.

Printed Name: Jeanne Lupton Signed: Jeanne Lupton**AMENDMENT TRANSMITTAL**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Amendment in the above-identified application.

The fee has been calculated as shown below.

	Claims After Amendment		Highest Previously Paid For	Present Extra	Small Entity Rate Fee	Large Entity Rate Fee
Total Claims	18	MINUS	33	00	x 9 =	x 18 = 00
Independent Claims	02	MINUS	07	00	x 42 =	x 84 = 00
Multiple Dependent Claim Present and Fee Not Previously Paid					\$140.00	\$280.00
Total					\$	\$0.00

- ☐ Applicant(s) hereby petition for a ____ month extension(s) of time to respond to the aforementioned Office Action.
- ☒ Applicant(s) believe that no (additional) Extension of Time is required; however, if it is determined that such an extension is required, Applicant(s) hereby petition that such an extension be granted and authorize the Commissioner to charge the required fees for an Extension of Time under 37 CFR 1.136 to Deposit Account No. 500388.
- ☐ Enclosed is our Check No. ____ in the amount of \$ ____ to cover the additional claim fee and/or extension of time fees.
- ☒ Please charge the required fees or any additional fees required to facilitate filing the enclosed response, to Deposit Account No. 500388 (Order No. VISAP016).

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP

Phillip R. Lee
Reg. No. 46,866

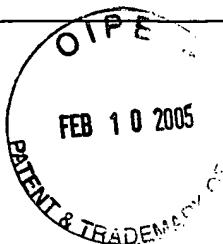
P.O. Box 778
Berkeley, CA 94704-0778

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Davis, et al.

Application No.: 09/359,083

Filed: July 22, 1999



Attorney Docket No.: VISAP016/P10500

Examiner: Pwu, Jeffrey C.

Group: 3628

Title: INTERNET PAYMENT,
AUTHENTICATION AND LOADING SYSTEM
USING VIRTUAL SMART CARD

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to the U.S. Patent and Trademark Office, Attention: Examiner Jeffrey Pwu at facsimile telephone number (703) 872-9306 on August 5, 2004.

Printed Name: Jeanne Lupton

Signed: A handwritten signature in cursive script, appearing to read "Jeanne Lupton", written over a horizontal line.

AMENDMENT D

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madame:

In response to the Office Action dated May 6, 2004, a response to which is due on August 6, 2004 please enter the following amendments and consider the following remarks:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 6 of this paper.

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (currently amended) An on-line purchase and load (OPAL) server for performing a transaction over a network using a virtual smart card, said OPAL server comprising:
 - a virtual smart card database having a plurality of records, each record including a virtual card identifier, ~~and a balance, a currency code, and a transaction log~~ corresponding to a single virtual smart card;
 - a hardware security module;
 - a smart card emulator that receives smart card commands and processes said commands in conjunction with said virtual smart card database and said hardware security module; and
 - a pseudo card reader module that receives said smart card commands and relays said commands to said smart card emulator, whereby said OPAL server performs a transaction over said network using one of said records in said virtual smart card database.
2. (original) An OPAL server as recited in claim 1 wherein said virtual card database further includes purchase algorithm identifiers, and wherein said hardware security module includes a plurality of purchase algorithms that are identified for use by one of said purchase algorithm identifiers, whereby said hardware security module may be used to perform cryptographic functions associated with a purchase.
3. (original) An OPAL server as recited in claim 1 further comprising:
 - a user verification module that verifies a user accessing said OPAL server and generates a user identifier, said user identifier being suitable to identify one of said virtual smart card records in said card database.
4. (original) An OPAL server as recited in claim 1 wherein said smart card emulator and said pseudo card reader module are implemented as a single software module.
5. (original) An OPAL server as recited in claim 1 wherein said network is an internet over which said OPAL server communicates with a merchant server and a payment server to transact a purchase.

6. (original) An OPAL server as recited in claim 1 wherein said network is an internet over which said OPAL server communicates with a bank server and a load server to load value onto said virtual smart card.

7. (original) An OPAL server as recited in claim 1 wherein said network is an internet over which said OPAL server communicates with a web server and an authentication server to authenticate a user.

8. (original) An OPAL server as recited in claim 1 wherein said OPAL server communicates over said network with a payment gateway for funding account authorization and clearing.

claims 9-33 (cancelled)

34. (previously presented) An OPAL server as recited in claim 1 wherein said smart card emulator is suitable for retrieving one of said records from said virtual smart card database, increasing or decreasing said balance of said record, and then returning said record to said virtual smart card database.

35. (new) An OPAL server as recited in claim 1 wherein each record of the virtual smart card database also includes a funding account number wherein the funding account number identifies an account that contains a monetary amount that can be loaded onto a virtual smart card.

36. (new) An OPAL server as recited in claim 1 wherein the OPAL server is further configured to receive a purchase request message from a client terminal, wherein the purchase request message indicates a good or service to be purchased by a user, a user identifier, and a user password.

37. (new) An OPAL Server as recited in claim 36 wherein the OPAL server is further configured to send a draw request message to a payment server, wherein the draw request message indicates an amount of money required to purchase the good or service and a merchant identifier.

38. (new) An OPAL Server as recited in claim 37 wherein the OPAL server is further configured to receive a debit command from the payment server, wherein the debit command indicates an amount of money to debit from a respective virtual smart card.

39. (new) An OPAL Server as recited in claim 38 wherein the smart card emulator is configured to debit itself in response to the debit command by the amount of money indicated in the debit command.

40. (new) An OPAL Server as recited in claim 38 wherein the OPAL server is further configured to send a debit response message to the client terminal, wherein the debit response message informs the user either that the amount of money has been debited from the smart card emulator or that money has not been debited from the smart card emulator due to a lack of sufficient funds.

41. (new) An on-line purchase and load (OPAL) server for performing a transaction over a network using a virtual smart card, said OPAL server comprising:

- a virtual smart card database having a plurality of records, each record including a virtual card identifier, a balance, a currency code, and a transaction log corresponding to a single virtual smart card;

- a hardware security module;

- a smart card emulator that receives smart card commands and processes said commands in conjunction with said virtual smart card database and said hardware security module, the smart card emulator also configured to send a load request message to a load server, wherein the load request message indicates a virtual smart card identifier and a load amount for a respective virtual smart card, the load amount indicating an amount of money to load onto the respective virtual smart card; and

- a pseudo card reader module that receives said smart card commands and relays said commands to said smart card emulator, whereby said OPAL server performs a transaction over said network using one of said records in said virtual smart card database.

42. (new) An OPAL server as recited in claim 41 wherein the OPAL server is configured to receive a load command from a load server wherein the amount of money indicated in the load request message is loaded onto the respective virtual smart card.

43. (new) An OPAL server as recited in claim 42 wherein the smart card emulator is configured to send a load response message to a client terminal, wherein the load response message informs a user that the amount of money has been loaded onto the respective virtual smart card.

REMARKS

In the Office Action, the Examiner rejected claims 1-8 and 34 under 35 U.S.C. §102(e) as being anticipated by Benson (EP 0,936,530). Reconsideration of the application is respectfully requested based on the following remarks.

Claims 35-43 have been added. Claim 1 has been amended to clarify the subject matter of the invention. Claims 1-8 and 34-43 are now pending in this application.

REJECTION OF CLAIMS 1-8 AND 34 UNDER 35 U.S.C. § 102

The present invention pertains to virtual smart cards used to facilitate online purchase transactions. On the other hand, Benson utilizes virtual smart cards in the computer security field. For example, the virtual smart cards of Benson can be used to obtain access to copy protected programs.

With respect to independent claim 1, the present invention recites a virtual smart card database having records wherein each record includes at least a balance, a currency code, and a transaction log that corresponds to a virtual smart card. The balance, a currency code, and a transaction log pertain to virtual smart cards used for purchase transactions. In contrast, Benson teaches a database that maintains information relating to computer security, such as cryptographic keys. Benson does not teach or suggest a record that includes a balance, a currency code, and a transaction log that corresponds to a virtual smart card. Therefore, it is submitted that Benson fails to teach or suggest claim 1. Since claims 2-8 and 34 depend from claim 1, it is submitted that these dependent claims are likewise patentably distinct from Benson for at least the same reasons.

New claims 35-43 recite limitations that also pertain to virtual smart cards used to facilitate online purchase transactions. Therefore, it is respectfully submitted that new claims 35-43 are also patentably distinct from Benson.

SUMMARY

It is respectfully submitted that all pending claims are allowable and that this case is now in condition for allowance. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

If any fees are due in connection with the filing of this Amendment, the Commissioner is authorized to deduct such fees from the undersigned's Deposit Account No. 50-0388 (Order No. VISAP016).

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP



Phillip P. Lee
Reg. No. 46,866

BEYER WEAVER & THOMAS, LLP
P.O. Box 778
Berkeley, CA 94704-0778

Telephone: (510) 843-6200
Facsimile: (510) 843-6203

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Davis et al.

Attorney Docket No.: VISAP016

Application No.: 09/359,083

Examiner: Ball, Paul

Filed: July 22, 1999

Group: 3628

Title: INTERNET PAYMENT,
AUTHENTICATION AND LOADING SYSTEM
USING VIRTUAL SMART CARD

STATEMENT OF Jeanne Lupton

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450


Sir:

I, Jeanne Lupton, declare as follows:

1. On August 5, 2004 I was working as a temporary patent secretary for the law firm of Beyer Weaver & Thomas.
2. At the direction of attorney Philip Lee, I sent via facsimile on August 5, 2004 to the U. S. Patent and Trademark Office a Request for Continued Examination (RCE) for application number 09/359,083 that also included an amendment transmittal and an amendment. I signed a certificate of transmission for each document.
3. The facsimile machine appeared to operate correctly and it was my belief at the time that all of these documents were transmitted to the Patent and Trademark Office. When the facsimile transmission report printed I placed it along with the above documents into the file and forwarded a copy of all documents to our docketing department as is our normal procedure.

4. It was not until recently when the law firm contacted me that I became aware that these documents might not have been received by the Patent and Trademark Office.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. I further declare that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both (under Section 1001 of Title 18 of the United States Code), and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Jeanne Lupton
1/31/05
Date